

REMARKS

The Office Action of September 29, 2003 has been carefully considered.

Initially, Applicants feel compelled to comment on the opening statement in the Office Action that "[T]he examiner does not understand why the Applicants are adding new claims that have the same subject matter as the claims that were rejected several times. Rather than amending the claims to overcome the rejections, the applicants prolong prosecution time of the application by adding similar claims that have already been rejected... New claims must be canceled."

To make it perfectly clear, claims 37-40 were added in the previous amendment to provide a *separate* set of claims in which the method included the administration of conjugated equine estrogens. This was done so that upon appeal of the claims, there would be a separate issue regarding claims 37-40. However, claims 37-40 have now been canceled; claim 30 has also been canceled.

Claims 25, 27-30, 33, 34 and 36-40 have been rejected under 35 USC 112, 1st paragraph, on the basis that the specification, "while being enabling for administering the combination of norgestrel and estradiol in a continuous on intermittent fashion, from 21-25 days per month (see lines 4-6, on page 4 of the specification), does not reasonably provide enablement for 'continuously without interruption...' The question is unlimited time in claim. How long will be 'continuous.' Specification discloses i.e. 21-25 days so claims must be limited to no. of days supported by disclosure."

Applicants believe that the Office Action has not properly interpreted the specification. The initial disclosure of the administration is provided in the second

complete paragraph on page 3 of the specification:

"The combined treatment is more often used in a continuous fashion, i.e. without interruption. However, some people are in favour of using it in an intermittent fashion, for example 25 days per month..."

Two methods of administration are therefore disclosed, one being defined as *continuous*, the other being defined as *intermittent*, the intermittent method being exemplified by administration 25 days per month.

These two methods of administration are repeated in the discussion of the invention on page 4 of the specification, where it is stated that "[T]he compositions according to the invention based on norgestrel and free or esterified estradiol or equine conjugated estrogens are administered in a continuous or intermittent fashion, from 21-25 days per month."

If this paragraph is interpreted based on the clear and unambiguous disclosure on page 3, it can only mean that in a first method, there is continuous administration without interruption, and in a second method, administration is from 21 to 25 days per month.

It is the method of continuous administration without interruption which is found in Example II, beginning on page 7 of the specification. In Example II, there is administration of norgestrel acetate and estradiol every day for the course of the study, 24 weeks.

Nevertheless, the Office Action states that the "specification discloses i.e. 21-25 days so claims must be limited to no. of days supported by the disclosure."

Moreover, the Office Action states that since "all the showing and discussions were based on continuous administration without bleeding, the invention as claimed does

not find support by the disclosure of the invention."

However, as should be clear from the above discussion, both the claims and the examples of the specification are directed to the embodiment in which the administration is continuous, without interruption, and not to the *separate and distinct embodiment* in which administration is interrupted, and takes place for 21-25 days per month.

As both the specification and claims provide support for continuous administration without interruption, withdrawal of this rejection is requested.

Claims 25, 27-30, 33, 34 and 36-40 have been rejected under 35 USC 112, 1st paragraph, on the basis that the specification is enabling for estradiol, but does not provide enablement to make and use the specification commensurate with these claims.

The Office Action alleges that "[C]laims are not limited to the scope to the extent of support in disclosure so that one skilled in the art without undue experimentation can practice invention" and further states that "[A] disclosure should contain representative examples, which provide reasonable assurance to one skilled in the art that the compounds fall within the scope of a claim will possess the alleged activity."

It is further noted that the Office Action states that "the invention provides a method of treating estrogenic deficiencies in women comprising administering without interruption combination of 0.5 to 3 mg of an estrogenic compound and 1.5 to 3.75 mg of norgestrel acetate."

The invention as presently claimed does not recite administering an "estrogenic compound" but rather recites administering "an estrogen selected from the group consisting of free and esterified estradiol" (claim 34 has been amended

hereinabove to utilize proper Markush group language). The term "free and esterified estradiol" represents a limited class of compounds; in order to provide evidence of this, Applicants have attached hereto an entry from the Merck Index, Tenth Edition (1983) for estradiol, as well as entries for α -estradiol, and estradiol esters, estradiol benzoate and estradiol 17 β -cypionate. The essential chemical formula for estradiol remains the same throughout, and it is well known in the art to claim salts and esters of pharmaceutical compounds without a specific example for every salt and ester claimed.

The present specification does contain representative examples that provide reasonable assurance that the *claimed compounds* (free and esterified estradiol) will possess the alleged activity. Example II of the specification reports on the administration of both a free estradiol, 17 β -estradiol, and an estradiol ester, estradiol valerate. Given that the term "estradiol" represents only a limited class of compounds, no reason is seen why the two examples reported should not provide reasonable assurance to one of ordinary skill in the art that the invention functions as disclosed in the specification.

Indeed, in the Office Action of February 8, page 8, 2000, the Examiner alleged that estradiol valerate would have the same properties as estradiol unless unexpected results are shown. The Office Action now takes the contrary position that the behavior of estradiol esters cannot be predicted and these compounds cannot be claimed unless proof is submitted that such compounds do have the same behavior.

With regard to conjugated equine estrogens, these compounds have been canceled from the claims. Nevertheless, Applicants point out that such compounds are well known in the art, and are represented by a commercially available product

sold under the name Premarin. Moreover, a combination of conjugated equine estrogens and a progestogen has been sold under the trademark Prempro®.

Given that estradiol and its esters represent a limited and well known class of compounds, and given that representative compounds were tested as part of the present application, Applicants submit that the present specification is enabling within the meaning of 35 USC 112, 1st paragraph, and withdrawal of this rejection is requested.

Claims 24, 25, 27-30, 33, 34, and 36-40 stand rejected under 35 USC 103 over Plunkett et al in view of Fraser et al.

Plunkett et al discloses a method for treatment of menopausal disorder comprising continuous administration of a progestogen in combination with estrogen, where the estradiol can be administered continuously or intermittently. While estradiols and their esters are disclosed, the only examples are directed to cyclic or intermittent administration of estrogens. Nomegestrol acetate is not disclosed.

Fraser et al discloses administration of nomegestrol acetate for 12 days per month, in combination with an estradiol implant. *All women treated with this regimen experienced withdrawal bleeding* in contrast to the claimed invention in which there is no withdrawal bleeding. Given that Plunkett et al has the object of minimizing withdrawal bleeding, Applicants submit that one of ordinary skill in the art would not have been led, based on Fraser et al, to combine nomegestrol acetate with estradiol with the expectation of eliminating withdrawal bleeding.

With regard to the declaration of Dr. Thomas submitted with the previous amendment, the Office Action poses the question of how much estradiol and nomegestrol acetate was used in each case. The information can be obtained by

reference to Fraser et al and the present specification. In Fraser et al, tests were conducted using 50 mg estradiol implants (daily dose not disclosed), and daily doses of 0.5, 1.0 and 2.5 mg of nomegestrol acetate. According to the present specification, tests were conducted with daily doses of 1.5 mg of 17 β -estradiol and 2 mg estradiol valerate, and 2.5 mg of nomegestrol acetate.

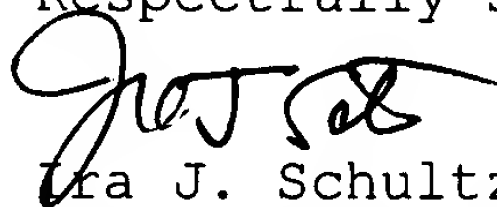
However, as noted in the declaration, Fraser et al does not enable one of ordinary skill to draw conclusions about the use of nomegestrol acetate in hormone replacement therapy because the estradiol plasma levels were very high and the nomegestrol was given for 12 days of a cycle. This was an unusual design for a sequential HRT combination, and was only a model to check the short term effects of different doses of nomegestrol acetate on the endometrium. Since withdrawal bleeding was observed by Fraser et al, it would not be expected that estradiol and nomegestrol acetate could be given according to the invention without withdrawal bleeding. Indeed, little can be concluded from Fraser et al, since the methodology is much different from the usual HRT methodology.

Finally, with regard to Table 3 of the declaration, Applicants note that nomegestrol acetate has been known for about 25 years, and a number of articles have been published reporting on studies of the properties of this compound. The Examiner should consider the invention to be what has been claimed, i.e. a method for treating estrogenic deficiencies in post menopausal women while avoiding the appearance of osteoporosis and withdrawal bleeding, by continuously without interruption administering to the women a composition containing from 0.5 to 3 mg of an estrogen selected from the group consisting of free or esterified estradiol and 1.5 to 3.75 mg of nomegestrol acetate by daily dose.

As the Fraser et al reference does not suggest to one of ordinary skill in the art that a daily dose without interruption of norgestrel acetate in combination with estradiol will result in satisfactory HRT treatment *without withdrawal bleeding*, Applicants submit that the claimed invention is patentable over the cited art, and withdrawal of this rejection is requested.

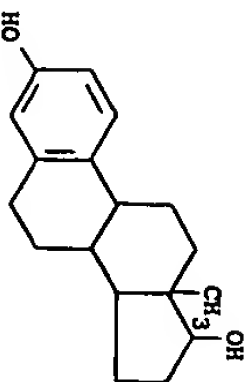
In view of the foregoing amendments and remarks, Applicants submit that the present application is now in condition for allowance. An early allowance of the application with amended claims is earnestly solicited.

Respectfully submitted,



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Registration No. 28666

estradiol; α -estradiol (obsoleted); *cis*-estradiol; 3,17-epidihydroestratriene; dihydrofollicular hormone; dihydrofolliculin; dihydroxyestrin; dihydrothelin; Computase 365; Dihydroformon; Dimenformon; Diogyn; Estrovite; Femestral; Gynergon; Gynocetyl; Lamiol; Macrodiol; Oestergon; Ovahormon; Ovasterol; Ovocylin; Ovocylin; Perlantol; Primofol; Profolol; Progynon-DH, $C_{18}H_{26}O_2$; mol wt 272.37. C 79.37%, H 8.88%, O 11.75%. The most potent naturally occurring estrogen in mammals; formed by the ovary, placenta, testis and possibly by the adrenal cortex. Has been isolated from follicular liquor of sow ovaries; from pregnancy urine of mares. Isolin: MacCorquodale *et al.*, *J. Biol. Chem.* 115, 435 (1936). Numerous preps from other steroids, e.g., Butenandt, Georgens, *Z. Physiol. Chem.* 248, 129 (1937); Hildebrandt, Schwenk; Logemann, Koester; Inhoffen; U.S. pat. 2,096,744; 2,225,419; 2,361,847 (1938, 1941, 1944 all to Schering). Inhoffen, Zühlstorf, *Ber.* 74, 1914 (1941). Total syntheses: U Eder *et al.*, *Ber.* 109, 2948 (1976); W. Oppolzer, D. A. Roberts, *Helv. Chim. Acta* 63, 1703 (1980). Comprehensive description of the valerate ester: K. Florey, Ed. in *Analytical Profiles of Drug Substances* vol. 4 (Academic Press, New York, 1975) pp 192-208.



Prisms from 80% alc, stable in air, mp 173-179°. $[\alpha]_D^{25} +76$ to $+83^\circ$ (dioxane), uv max: 225, 280 nm. Precipitated by digitonin. Almost insol in water; freely sol in alcohol; sol in acetone, dioxane, other organic solvents; solns of fixed alkali hydroxides; sparingly sol in vegetable oils. 1 mg = 10,000 international units.

3-Benzate, see separate entry.

17B-Cypionate, see separate entry.

17-Propionate, $C_{21}H_{30}O_3$, *Acrofolin*, *Akrofolin*, mp 199-200°. See Miescher, Scholz, *Helv. Chim. Acta* 20, 263 (1937). U.S. pat. 2,160,555; 2,233,025 (1939, 1941 to Ciba).

Dipropionate, $C_{24}H_{34}O_4$, *Agofol*, *Agofol*, *Dimenformon Dipropionate*, *Diowocytin*, *Ovocylin Dipropionate*, *Ovocylin-P*, *Progynon-DP*, mp 104-105°, Miescher, Scholz, U.S. pat. 2,160,555; 2,205,627; 2,233,025 (1939, 1940, 1941 to Ciba). Hemisuccinate, $C_{22}H_{32}O_5$, *Eutocol*.

17-Heptanoate, $C_{22}H_{36}O_3$, *estradiol enanthate*, *SQ 16150*, Crystals from diisopropyl ether, mp 94-96°, Gauthier *et al.*, *Ann. Pharm. Franc.* 16, 757 (1958).

17-Undecanoate, $C_{26}H_{40}O_3$, *estradiol undecylate*, *Delastrec*, mp 105-106°. $[\alpha]_D^{25} +42^\circ$ (chloroform), uv max: 280-282 nm ($\log \epsilon$ 3.30). Prep: Ringold *et al.*, U.S. pat. 2,990,414 (1961 to Syntex).

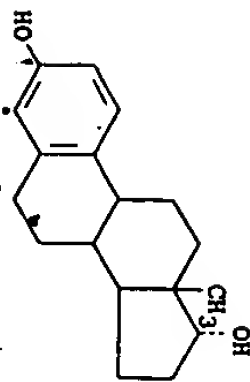
17-Valerate, $C_{21}H_{32}O_3$, *Delastrogen*, *Progynova*, Crystals, mp 144-145°, Miescher, Scholz, U.S. pat. 2,205,627; 2,233,025.

Note: A mixture of estradiol with medroxyprogesterone 17-acetate is marketed as *Provest*.

Therap cat: Estrogen.

Therap cat (vet): Estrogenic hormone therapy.

3649. α -Estradiol. *Estra-1,3,5(10)-triene-3,17 α -diol*; 1,3,5-estratriene-3,17 α -diol; 3,17-dihydroxyestratriene. $C_{18}H_{26}O_2$; mol wt 272.37. C 79.37%, H 8.88%, O 11.75%. Has been isolated from pregnancy urine of mares. Prep from β -estradiol by inversion of the hydroxyl group at C-17 after tosylation: Allais, Hoffmann, U.S. pat. 2,835,681 (1958).

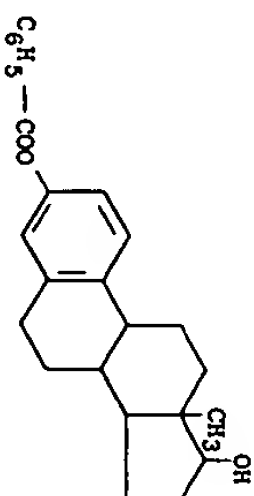


Needles with $\frac{1}{2}H_2O$ from 80% alcohol, mp 220-223°. $[\alpha]_D^{25} +53^\circ$ to $+56^\circ$ (c = 0.9 in dioxane). Not precipitated by digitonin (in 80% alcoholic soln). Soluble in alcohol, acetone, aq alkalis. One gram dissolves in more than 100 ml of boiling benzene. Slightly sol in ether, chloroform. Insol in water, aq dil acids.

Diacetate, $C_{22}H_{34}O_4$, mp 140-142°.

3-Benzate, $C_{25}H_{38}O_3$, mp 156-157°, also reported as polymorphous: I, mp 63°; II, mp 153°; III, mp 158°.

3650. **Estradiol Benzoate**. β -Estradiol-3-benzoate; oestradiol monobenzoate; Benovocytin; Benzhormovarin; Benzoestrolol; Benzofoline; Benzo-Gynocetyl; de Graafina; Difolisterol; Difolliculine; Dimenformon benzoate; Diogyn B; Eston-B; Femestrone; Follicormon (ampuls); Follidin (ampuls); Graafina; Gynécormone; Hidroestron; Hormogynon; Motovar; Oestroform; Ovasterol-B; Oves B; Ovocylin Benzoate; Ovocylin M; Ovocylin-MB; Primogyn B; Primogyn I; Progynon-B; Progynon Benzoate; Rechormone Oestradiol; Solestro; Unistradiol. $C_{25}H_{38}O_3$; mol wt 376.50. C 79.75%, H 7.50%, O 12.75%. Preparation: Schwenk, Hildebrandt, U.S. pat. 2,054,271 (1936 to Schering-Kahlbaum); Sandulesco, Brit. pat. 445,388 (1938 to Lab. Franc. Chimiother.).

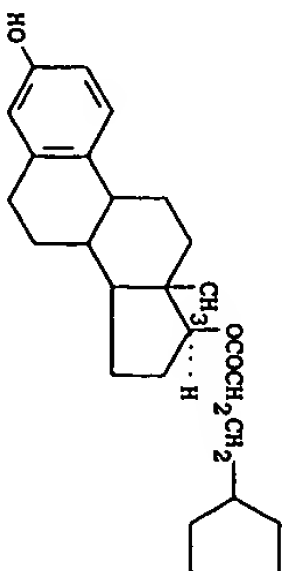


Crystals from alc, mp 191-196°. Stable in air. $[\alpha]_D^{25} +58$ to $+63^\circ$ (c = 2 in dioxane). Sol in alc, acetone, dioxane; slightly sol in ether, vegetable oils. 1 mg = 10,000 international estradiol benzoate units. Precipitated by digitonin. 17B-Maltoside heptacetate, $C_{51}H_{82}O_{20}$, dec 227-229°. $[\alpha]_D^{25} +56^\circ$ (methanol). Sol in water; very sol in glucose solns: Meysier, Miescher, *Helv. Chim. Acta* 27, 235 (1944). 17B-Maltoside hydrate, $C_{50}H_{84}O_{21} \cdot H_2O$, dec 272-282°. $[\alpha]_D^{25} +52^\circ$ (c = 1.07 in methanol). Sol in water; very sol in glucose solns: *idem*, *ibid.* 1154, 1157.

Therap cat: Estrogen.

Therap cat (vet): Estrogenic hormone therapy.

3651. **Estradiol 17B-Cypionate**. Estradiol 17B-cyclopentanepropionate; estradiol 17B-cyclopentylpropionate; ECP; Depoestradiol; Depofemin; Estraderp. $C_{26}H_{40}O_3$; mol wt 396.55. C 78.74%, H 9.15%, O 12.10%. Prep by treating estradiol 3,17B-dicyclopentanepropionate with potassium carbonate: Ott, U.S. pat. 2,611,773 (1952 to Upjohn).



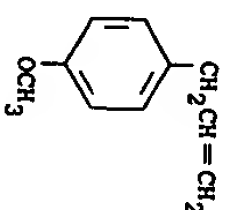
Crystals from benzene + petr ether, mp 151-152°. $[\alpha]_D^{25} +45^\circ$ (chloroform). Sol in ether, methanol, benzene, chloroform, peanut oil, cottonseed oil, corn oil, sesame oil. The limit of soly in the oils is about 400 mg/ml. Thixotropic gels may be prep by adding aluminum monostearate to the oil solns.

Therap cat: Estrogen.

Therap cat (vet): Estrogenic hormone therapy.

3652. **Estragole**. 1-Methoxy-4-(2-propenyl)benzene; *p*-allylanisole; chavicol methyl ether; estragol. $C_{10}H_{12}O$; mol wt 148.20. C 81.04%, H 8.16%, O 10.80%. Main constituent of *tarragon oil* (*estragon oil*), the oil from *Arenaria dracunculifolia* L., *Compositae* (*estragon*) where it occurs to an extent of 60-75%; Grimaux, *Bull. Soc. Chim.* [3] 11, 34 (1894); Daufresne, *ibid.* [4] 3, 333 (1908). Occurs also in pine oil

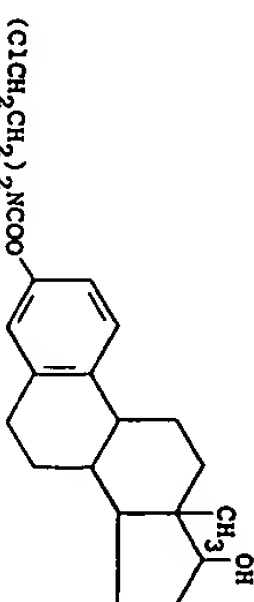
and in American turpentine oil. Prep: Tiffeneau, *Compt. Rend.* 139, 482 (1904); Verley, *Ger. pat.* 154,654; D. Wigfield, K. Taymaz, *Tetrahedron Letters* 1973, 4841; P. Gramatica *et al.*, *Gazz. Chim. Ital.* 104, 629 (1974).



Liquid, d_4^{20} 0.9645, b_p^{25} 216°, b_p^{25} 108-114°, b_p^{25} 95-96°. n_D^{25} 1.5230. Sol in alcohol, chloroform. Forms azetropic mixtures with water. LD₅₀ orally in rats, mice: 1820, 1250 mg/kg. P. M. Jenner *et al.*, *Food Cosmet. Toxicol.* 2, 327 (1964).

use: In perfumes and as flavor in foods and liquors.

3653. **Estramustine**. *Estra-1,3,5(10)-triene-3,17-diol 3-bis(2-chloroethyl)carbamate*; estradiol 3-bis(2-chloroethyl)carbamate; estra-1,3,5(10)triene-3,17B-diol 3-[N,N-bis(2-chloroethyl)carbamate]; Ro 21-8837. $C_{27}H_{38}Cl_2NO_3$; mol wt 440.41. C 62.72%, H 7.10%, Cl 16.10%, N 3.18%, O 10.90%. Estradiol to which nitrogen mustard is bound. Prep: Belg. pat. 646,319 corresp to Fex *et al.*, U.S. pat. 3,299,104 (1963, 1967, to Leo). Niculescu-Duvaz *et al.*, *J. Med. Chem.* 10, 172 (1967). Clinical results: Anderes, *Praxis* 60, 1375 (1971); Muntzing, Nilsson, *Z. Krebsforsch. Klin. Onkol.* 77, 166 (1972).



Crystals from benzene-petr ether, mp 104-105°. $[\alpha]_D^{25} +50^\circ$ (in dioxane), uv max (alcohol): 270.7, 276.5 nm. 17-Phosphate, $C_{27}H_{38}Cl_2NO_6P$, *Estracyl*, mp 155° (dec). $[\alpha]_D^{25} +30^\circ$ (dioxane). Sol in aqueous and alkali solns. 17-(Dihydrogenphosphate), disodium salt, $C_{27}H_{38}Cl_2N_2Na_2O_6P$, *Emcyf*.

Therap cat: Antineoplastic.

3654. **Estrinol**. *Estra-1,3,5(10)-triene-3,16,17-triol*; 1,3,5-estratriene-3 β ,16 α ,17 β -triol; 3,16 α ,17 β -trihydroxy- $\Delta^{1,3,5}$ -estratriene; 16 α -hydroxyestradiol; follicular hormone hydrate; oestrin; trihydroxyestrin; Aacifemine; Destriol; Hormoned; Klimoral; Oekolp; Ovesterin; Ovestin; Theolol; Tridestin; Trovex. $C_{18}H_{26}O_3$; mol wt 288.37. C 74.97%, H 8.39%, O 16.64%. A metabolite of, and considerably less potent than 17 β -estradiol (q.v.). It is usually the predominant estrogenic metabolite found in urine. During pregnancy the placenta produces relatively large amounts of estrinol. Isolin from human pregnancy urine: Martian, *Biochem. J.* 23, 1090, 1233 (1929); probably occurs as a glycuronide: Cohen, Martian, *ibid.* 29, 1577 (1935). Isolin from human placenta: Collip, *Brit. Med. J.* 1930, II, 1080; Collip *et al.*, *Endocrinology* 18, 71 (1934). Also obtained from plant sources. Isolin from pussywillows: Skarzynski, *Nature* 131, 766 (1933). Structure: Huffman, Lott, *J. Am. Chem. Soc.* 69, 1835 (1947). Crystal and molecular structure: Cooper *et al.*, *Acta Crystallogr.* 25B, 814 (1969). Partial synthesis: Huffman, *J. Biol. Chem.* 169, 167 (1947). Syntheses: Huffman, Lott, *J. Am. Chem. Soc.* 71, 719 (1949); Leeds *et al.*, *ibid.* 76, 2943 (1954).

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